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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,861	03/08/2004	Paul Calabresi	21486-031CON2	2424
36623 7590 02/26/2008 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111				
EXAMINER				
HAGHIGHATIAN, MINA				
ART UNIT		PAPER NUMBER		
1616				
MAIL DATE		DELIVERY MODE		
02/26/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/796,861

Applicant(s)

CALABRESI ET AL.

Examiner

Mina Haghighatian

Art Unit

1616

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5-8, 10-13, 17-20, 22-24 and 78-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5-8, 10-13, 17-20, 22-24 and 78-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/07 has been entered.

Receipt is acknowledged of the Amendments and Remarks filed on 10/31/07. Claims 1, 6, 7, 13, 18 and 19 have been amended while claims 2-4 and 14-16 have been cancelled. New claims 78-85 have been added. Accordingly, claims **1, 5-8, 10-13, 17-20, 22-24 and 78-85** are pending.

Claim Rejections - 35 USC § 102

The rejection of claims 1-3, 5, 7-8, 10-15, 17, 19-20 and 22-24 under 35 U.S.C. 102(e) as being anticipated by Stendel et al (6,479,481) has been obviated by amendments.

Claim Rejections - 35 USC § 103

The rejection of claims under 35 U.S.C. 103(a) have been withdrawn due to amendments and arguments.

Double Patenting

The **nonstatutory** double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **1, 5-8, 10-13, 17-20, 22-24 and 78-85** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,703,413. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims **1, 5-8, 10-13, 17-20, 22-24 and 78-85** are generic to all that is recited in claims 1-19 of U.S. Patent No. 6,703,413. That is, claims 1-19 of U.S. Patent No. 6,703,413 fall entirely within the scope of claims **1, 5-8, 10-13, 17-20, 22-24 and 78-85** or, in other words, claims **1, 5-8, 10-13, 17-20, 22-24 and 78-85** are anticipated by claims 1-19 of U.S. Patent No. 6,703,413. Specifically instant claims are drawn to a method of inhibiting growth of tumor cells or a method of killing a tumor cell comprising administering a composition comprising taurolidine, taurultam or a biologically active derivative thereof. These are the same limitations set forth in claims of U.S. Patent No. 6,703,413.

Claims **1, 5-8, 10-13, 17-20, 22-24 and 78-85** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-43 of U.S. Patent No. 6,995,164. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims **1, 5-8, 10-13, 17-20, 22-24 and 78-85** are generic to all that is recited in claims 1-43 of U.S. Patent No. 6,995,164. That is, claims 1-43 of U.S. Patent No. 6,995,164 fall entirely within the scope of claims **1, 5-8, 10-13, 17-20, 22-24 and 78-85** or, in other words, claims **1, 5-8, 10-13, 17-20, 22-24 and 78-85** are anticipated by claims 1-43 of U.S. Patent No. 6,995,164. Specifically, instant claims are drawn to a method of inhibiting growth of tumor cells or a method of killing a tumor cell comprising administering a composition comprising taurolidine, taurultam or a biologically active derivative thereof. These are the same limitations set forth in claims of U.S. Patent No. 6,995,164.

Claims **1-8, 10-20 and 22-24** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 11/350,313. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims **1, 5-8, 10-13, 17-20, 22-24 and 78-85** are generic to all that is recited in claims of the copending application 11/350,313. In other words claims **1, 5-8, 10-13, 17-20, 22-24 and 78-85** are anticipated by claims of the copending application 11/350,313.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed 10/31/07, with respect to rejections under 35 USC 102(e) and under 35 USC 103(a) have been fully considered and are persuasive. The said rejections has been withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mina Haghighatian whose telephone number is 571-272-0615. The examiner can normally be reached on core office hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mina Haghighatian/

Mina Haghighatian
Patent Examiner
February 19, 2008